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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Chien-Chao Huang, et al.

Serial No.: 10/824,854

Filed: April 15, 2004

For: METHOD OF MANUFACTURING
A MICROELECTRONIC DEVICE
WITH ELECTRODE PERTURBING
SILL

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Attorney Docket No.
2003-0964 / 24061.150

Customer No. 42717

Group Art Unit: 2826

Examiner: Thomas L. Dickey

Confirmation No.: 6844

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that this correspondence (including any listed enclosures) is being facsimile transmitted to the United States Patent and Trademark Office at (571) 273-8300 on February 16, 2007.


Linda Ingram

PETITION UNDER 37 C.F.R. §1.113
FOR REVIEW OF FINALITY

Pursuant to MPEP §1002.02(c)(3)(a), §706.07(a) and (c), and 37 C.F.R. §1.113(a) and §1.181, **it is respectfully requested that this Petition be forwarded to the Director of Technology Center 2800 for consideration and decision.** No fee is required in association with this Petition. The relevant facts are as follows:

1. When the present application was filed on April 15, 2004, the application papers included an Information Disclosure Statement (IDS). This IDS is the only IDS filed by Applicants to date.

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2. On July 18, 2006, Examiner Dickey issued an Office Action.
3. On August 11, 2006, Applicants filed a Response to the July 18 Office Action. The Response did not amend the claims.
4. On November 21, 2006, the Examiner issued another Office Action, which (1) cited new art (Abadeer U.S. Patent Publication No. 2004/0036118), (2) presented a new ground of rejection based on the new art (Abadeer), and (3) presented another new ground of rejection based on previously-cited art (Montgomery U.S. Patent Application Publication No. 2004/0208454). This November 21 Office Action was designated as a final rejection. The issue in this Petition is the finality of the November 21 Office Action.
5. On December 13, 2006, Applicants filed a Response to the November 21 Office Action. The Response traversed the finality of the November 21 Office Action, and requested reconsideration of the finality.
6. On January 24, 2007, the Examiner issued an Advisory Action, indicating that he was maintaining the finality of the November 21 Office Action.
7. On February 12, 2007, the undersigned contacted the Examiner by telephone to discuss the finality issue. The Examiner declined to discuss finality, indicating that he was following a policy dictated by Supervisory Primary Examiner (SPE) Sue Purvis. The Examiner requested that the undersigned directly contact SPE Purvis to discuss the finality issue.
8. On February 14 and 15, 2007, the undersigned discussed the finality issue with SPE Purvis. SPE Purvis also refused to withdraw the finality of the November 21 Office Action.

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MPEP §706.09(a) discusses the circumstances under which an Office Action can properly be designated as a "final" rejection. For convenience, the relevant provisions of MPEP §706.07(a) are reproduced here, and specify that

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In other words, if an examiner takes a position, and after that the applicant engages in certain conduct that forces the examiner to take a new and different position, the examiner may be able to make the new position a final rejection. But that's not what happened here. After receiving the July 18 Office Action, Applicants did not engage in any of the conduct that is specified in MPEP §706.07(a) and that would give the Examiner justification for issuing a final action citing new art and introducing a new ground of rejection based on that art. In particular, after receiving the July 18 Office Action, Applicants did not amend the claims, and did not submit an IDS. What happened here is discussed in MPEP §706.07, which also discusses finality, and which explains that:

[The] invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied Switching . . . from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will . . . tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection. . . . [P]resent

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practice does not sanction hasty and ill-considered final rejections.

The applicant . . . should . . . not be prematurely cut off in the prosecution of his or her application. . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

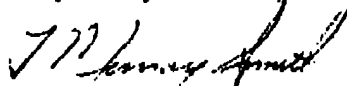
In the present situation, the Examiner acted contrary to MPEP §706.07. In particular, the Examiner failed to comply with the PTO requirement that "the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied". (If the Examiner had thoroughly searched the invention as disclosed and claimed, and had fully applied the references, the Abadcer reference would have been cited and applied in the July 18 Office Action, or even earlier). Instead, the Examiner took an approach here that MPEP §706.07 explicitly discourages. In particular, the Examiner engaged in piecemeal examination that involved "[s]witching . . . from one set of references to another . . . in rejecting in successive actions claims of substantially the same subject matter". Although the MPEP does not completely prohibit this approach, MPEP §706.07(a) does prohibit the Examiner from issuing final office actions while engaging in this approach.

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Applicants respectfully request that the Director of Technology Center 2800 grant this Petition, and direct the Examiner to withdraw the finality of the Office Action mailed on November 21, 2007.

Respectfully submitted,



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Date: February 16, 2007

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Enclosures: None

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